

REMARKS

Claims 1 - 38 are pending in the application.

Claims 1 - 38 are rejected.

Claims 1-6, 9-38 are amended.

No claims are cancelled.

The Office Action of April 9, 2007 has been received and its contents carefully noted. The amendments are made to more fully point out and distinctly claim the subject matter Applicant considers as their invention. The amendments are fully supported by the specification and drawings and do not present new issues for consideration. Allowance of the application and claims is respectfully requested in view of the following discussion.

Claim Rejections Under §102

In section 2, on page 2 of the Office Action, claims 1-2, 4, 14-15, 18 and 27 are rejected under 35 U.S.C. § 102(b) as anticipated by Holstrom et al. (U.S. Patent No. 6,198,939).

Turning now to the rejections under 35 U.S.C. § 103, claims 3, 9-10, 12-13, 16-17, 19-26 and 28-38 have been rejected by the Examiner on the grounds of alleged obviousness in view of Holstrom.

The Office asserts that Holstrom teaches all the structural limitations of the claimed invention *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987) as the basis for the rejection. However, even if a cited reference discloses all the functions recited in the claims, the cited reference cannot anticipate the claim if there is any structural difference. *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999). It is well settled a single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim. *Verdegaal Bros., Inc., v. Union Oil Co.*, 2 USPQ2d 1051 (Fed. Cir. 1987). Inherent anticipation requires that the missing descriptive material is "necessarily present," not merely, probably or possibly present, in the prior art. *Trintec Industries, Inc. v. Top-U.S.A. Corp.* 63 USPQ2d 1597, (Fed. Cir. 2002).

Applicants respectfully disagree with the rejection of claims 1-2, 4, 14-15, 18 and 27 as being anticipated by Holstrom for the following cogent reasons.

Applicants' invention as disclosed and claimed, provides hinting capabilities in a portable electronic device such as a mobile telephone, for hinting or providing clues to one or more next possible sub-operational functionalities that may be available in the selected operational functionality for assisting a user of the mobile telephone in any of a given selected operational functionality (see for example, specification, page 3, lines 4-7; page 9, line 22; page 10, line 24 to page 11, line 1; page 11, lines 18-20). In other words, one or more next possible available actions that the user may take in operating the mobile telephone in a given operational functionality are hinted or suggested to the user automatically without the user taking any specific steps to invoke the hinting capability.

In contrast to Applicants' invention for providing hinting capabilities, Holstrom discloses a man-machine interface help and search tool in association with a menu structure and selection capability to instruct the user how to find, activate, or select a desired function of the phone. See Holstrom, abstract; column 2, lines 25-27.

The man-machine interface help and search tool in association with a menu structure and selection capability to instruct the user how to find, activate, or select a desired function of the phone discussed in Holstrom requires that the user place the mobile phone in a "search-mode". See Holstrom column 2, lines 28-32. The help function is implemented through a search feature allowing the user to enter a command or search for a command regarding a specific subject of interest to the user, See Holstrom column 2, lines 33-40. Once the user has found the desired command the search tool can point out how the command may be accessed and activated. See Holstrom, column 2 lines 47-49. Once the processor finds the command or the closest matching set of commands they are displayed and the user is prompted to select a command from the list displayed or the user may enter another search. See Holstrom column 4, lines 38-52. The user is then able to read the help information and is prompted to see if the user desires to use the command and is sent to the appropriate command menu. See Holstrom column 4, lines 55-57. The user must enter the search-mode to activate the search function, See Holstrom column 5,

lines 14-29, and then enter a search string such as a topic, partial command, initials of the command, or function name the user wishes to find. See Holstrom column 5, lines 29-33. The processor executes a search algorithm and finds a unique function name or displays a list of all commands. See Holstrom column 5, lines 49-67. In all instances, Holstrom is a menu driven help and search tool and requires the user to take some positive action to initiate a search, select one or more commands of interest from the search results, learn about the commands, and then make a decision as to whether or not to select the command to carry out a desired function.

Instead, Holstrom at least fails to disclose or suggest hinting one or more next possible sub-operational functionalities in the selected operational functionality, as required in claim 1.

Therefore, for at least the reasons discussed above, applicants respectfully submit that Holstrom does not teach each and every element of applicants' invention as set forth in independent claims 1, 14, 18, 27 and 28 and thus does not anticipate applicants' invention under 35 U.S.C. §102. The remaining claims of the application are dependent directly or indirectly upon independent claims 1, 14, 18, 27 and 28 and it is submitted that they too are not anticipated for similar reasoning and for further limitations clearly set forth therein.

#### Claim Rejections Under § 103

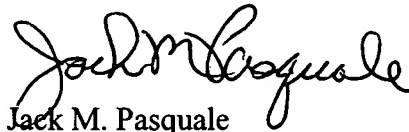
In section 6, on page 6 of the Office Action, claim 5 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hofmann. In section 7, on page 7 of the Office Action, claim 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hofmann in view of Kobayashi (U.S. Appl. Publ. No. 2001/0034659). Claim 5 ultimately depends from independent claim 1, and is not disclosed or suggested by Hofmann at least in view of its dependency. Combining the teachings of Kobayashi with the teachings of Hofmann, even if such a combination could be made, does not overcome the fundamental deficiencies of Hofmann and the rejection of claim 17 should be withdrawn at least due to the dependency of claim 17.

Attorney Docket No.: 944-004.036  
Application No.: 10/686,504

Conclusion

Applicants submit that all the claims of the application are now in condition for allowance and earnestly solicit such action at an early date. The Examiner is invited to call Applicants' attorney if any questions remain following review of this response.

Respectfully submitted,



Jack M. Pasquale  
Attorney for the Applicant  
Registration No. 31,052

Date: July 30, 2007

WARE, FRESSOLA, VAN DER SLUYS  
& ADOLPHSON LLP  
755 Main Street, P.O. Box 224  
Monroe, Connecticut 06468  
(203) 261-1234